

ESTTA Tracking number: **ESTTA726533**

Filing date: **02/11/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Trek Bicycle Corporation		
Entity	Corporation	Citizenship	Wisconsin
Address	801 W Madison Street Waterloo, WI 53594 UNITED STATES		

Attorney information	Mary Catherine Merz Merz & Associates, P.C. 1010 Lake Street, Suite 400 Oak Park, IL 60301 UNITED STATES docket@merz-law.com Phone:7083838801
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Applicant Information

Application No	86740842	Publication date	01/19/2016
Opposition Filing Date	02/11/2016	Opposition Period Ends	02/18/2016
Applicant	NIITSUMA, Katsuhiko 3-8-8 Ikebukuro, Toshima-ku Tokyo, 171-0014 JAPAN		

Goods/Services Affected by Opposition

<p>Class 018. First Use: 0 First Use In Commerce: 0</p> <p>All goods and services in the class are opposed, namely: Handbag frames; purse frames; industrial packaging containers of leather; clothing for domestic pets; bags and the like, namely, handbags, sport bags, carry-all bags; pouches and the like, namely, pouches for packaging of leather, Drawstring pouches, Japanese utility pouches (shingen-bukuro), Leather pouches; Unfitted vanity cases; umbrellas and their parts; walking sticks; canes; metal parts of canes and walking-sticks; handles for canes and walking-sticks; saddlery; Unworked or semi-worked leather; fur sold in bulk</p>
<p>Class 025. First Use: 0 First Use In Commerce: 0</p> <p>All goods and services in the class are opposed, namely: Non-Japanese style outerclotthing, namely, jackets, pants, shirts, skirts; coats; sweaters; shirts; nightwear; underwear; swimwear; swimming caps; camisoles; tee-shirts; Japanese traditional clothing,namely, Japanese sleeping robes (nemaki), bustle holder bands for obi, Kimonos;sleep masks; aprons; collar protectors;socks and stockings; puttees and gaiters; fur stoles; shawls; scarves; Japanesestyle socks (tabi); Japanese style socks covers (tabi covers); gloves and mittens; neckties; neckerchieves; bandanas; thermal underwear; mufflers; ear muffs; nightcaps; headwear; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear not for sports; clothes for sports, namely, tights, tank tops, shorts, uniforms; special footwear forsports</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	1168276	Application Date	04/21/1980
Registration Date	09/08/1981	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1977/03/10 First Use In Commerce: 1977/03/10 Bicycles and Bicycle Frames		


U.S. Registration No.	1989281	Application Date	11/29/1994
Registration Date	07/23/1996	Foreign Priority Date	NONE
Word Mark	TREKKING		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1996/01/00 First Use In Commerce: 1996/01/00 bicycles		

U.S. Registration No.	1994479	Application Date	10/03/1994
Registration Date	08/20/1996	Foreign Priority Date	NONE
Word Mark	TREK 100		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 providing ride support vehicles in competitive and recreational events, namely bicycle tours, bicycle races, and triathlons		

U.S. Registration No.	2060274	Application Date	10/06/1994
Registration Date	05/13/1997	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1990/09/00 First Use In Commerce: 1990/09/00 cycling computers and head protective helmets for bicycle users Class 012. First use: First Use: 1993/01/00 First Use In Commerce: 1993/01/00 bicycles, bicycle frames, and a full line of parts and accessories for bicycles,		

	<p>namely, handlebars, [handlebar end extensions, handlebar stems,] seats, seat posts, seat post clamps and binder bolts, [tires, tire innertubes, pedals,] forks for supporting bicycles upon bicyclewheels, [bicycle suspensions, wheels and wheel rims,] water bottles, water bottle cages, bicycle mounted racks, [bicycle carrying racks for motor vehicles,] tools and tire repair kits for bicycles, lock holders, [audible warning devices, namely, bells for bicycles,] lighting systems for bicycles [and bicycle fenders]</p> <p>Class 028. First use: First Use: 1993/10/00 First Use In Commerce: 1993/10/00 exercise equipment, namely, stationary exercise cycles</p>
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U.S. Registration No.	2687012	Application Date	03/01/2000
Registration Date	02/11/2003	Foreign Priority Date	NONE
Word Mark	ETREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2002/09/30 First Use In Commerce: 2002/09/30 On-line retail and wholesale store services, featuring a wide range of consumer-products, except footwear, all provided via the Internet		

U.S. Registration No.	2742116	Application Date	10/04/2002
Registration Date	07/29/2003	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1998/09/30 First Use In Commerce: 1998/09/30 bicycles and bicycle frames		


U.S. Registration No.	2745442	Application Date	01/05/1998
Registration Date	08/05/2003	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	<p>Class 025. First use: First Use: 1988/06/00 First Use In Commerce: 1988/06/00 bicycling apparel, namely, bicycling jersey; form fitting and reinforced seat elastic shorts; ankle length socks; wind resistant jackets with enhanced visibility fabric, extra sleeve length, high collar and extended length back panel; vests with enhanced visibility fabric, high collar and extended length back panel</p> <p>Class 028. First use: First Use: 1988/06/00 First Use In Commerce: 1988/06/00 padded and reinforced fingerless bicycling gloves</p>

U.S. Registration No.	2876977	Application Date	09/27/2001
Registration Date	08/24/2004	Foreign Priority Date	NONE
Word Mark	TREKLITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1977/12/22 First Use In Commerce: 1979/07/17 orienteering equipment and clothing for outdoor sporting activities, namely, protective outer wear</p> <p>Class 025. First use: First Use: 1977/12/22 First Use In Commerce: 1979/07/17 orienteering equipment and clothing for outdoor sporting activities, namely, leggings, pants, gators, shirts, and jackets</p>		

U.S. Registration No.	3031210	Application Date	06/28/2004
Registration Date	12/20/2005	Foreign Priority Date	NONE
Word Mark	TREK TRAVEL		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 039. First use: First Use: 2002/10/01 First Use In Commerce: 2002/10/01 Arranging travel tours featuring hiking, river rafting, whale watching, kayaking, and bicycling; cultural tours, namely, conducting sightseeing tours for others</p> <p>Class 041. First use: First Use: 2002/10/01 First Use In Commerce: 2002/10/01 Sporting and cultural activities related to bicycling, namely, wine tastings and cultural tours, namely, guided tours of wineries</p> <p>Class 043. First use: First Use: 2002/10/01 First Use In Commerce: 2002/10/01 Services for providing food and drinks and temporary lodging for those participating in bicycling activities and cultural activities related to bicycling, namely, hiking, river rafting, cultural tours, wine tastings, whale watching and kayaking</p>		


U.S. Registration No.	3042834	Application Date	07/08/2004
Registration Date	01/10/2006	Foreign Priority Date	NONE
Word Mark	TREK UNIVERSITY		


Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2004/10/01 First Use In Commerce: 2004/10/01 Instructional and training services in the field of retailing bicycles, bicycleclothing and bicycle accessories, and in the fields of bicycle safety, bicycle recreation, bicycle service and bicycle repair

U.S. Registration No.	3053077	Application Date	10/21/2003
Registration Date	01/31/2006	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1993/01/31 First Use In Commerce: 1993/01/31 backpacks, [fanny packs,] textile totebags, [hip packs,] messenger bags, rack-trunks, saddle bags, bicycle seat packs, all purpose sports bags		

U.S. Registration No.	3066516	Application Date	11/06/2002
Registration Date	03/07/2006	Foreign Priority Date	NONE
Word Mark	TREKER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 2002/11/00 First Use In Commerce: 2002/11/00 OFF-ROAD ALL-TERRAIN UTILITY VEHICLES		

U.S. Registration No.	3397739	Application Date	07/03/2007
Registration Date	03/18/2008	Foreign Priority Date	NONE
Word Mark	TREK BICYCLE STORE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1996/09/01 First Use In Commerce: 1996/09/01 retail stores featuring bicycles


U.S. Registration No.	3516346	Application Date	03/27/2008
Registration Date	10/14/2008	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2002/09/30 First Use In Commerce: 2002/09/30 On-line retail and wholesale store services featuring a wide range of consumer products except footwear all provided via the Internet		


U.S. Registration No.	3576106	Application Date	07/31/2008
Registration Date	02/17/2009	Foreign Priority Date	NONE
Word Mark	TREK STOP		

Design Mark	TREK STOP
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2008/06/30 First Use In Commerce: 2008/06/30 retail vending services in the field of automated vending machines that dispenses bicycle parts, bicycle accessories, energy bars, beverages and gels


U.S. Registration No.	3653169	Application Date	02/05/2008
Registration Date	07/14/2009	Foreign Priority Date	NONE
Word Mark	TREK 100		
Design Mark	Trek 100		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1989/05/01 First Use In Commerce: 1989/05/01 Charitable fund raising services by means of bicycle rides and entertainment events		


U.S. Registration No.	3709688	Application Date	05/16/2008
Registration Date	11/10/2009	Foreign Priority Date	NONE
Word Mark	TREK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 032. First use: First Use: 2009/08/10 First Use In Commerce: 2009/08/10 Powders used in the preparation of sports drinks and energy drinks

U.S. Registration No.	3789682	Application Date	08/05/2009
Registration Date	05/18/2010	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1989/05/01 First Use In Commerce: 1989/05/01 Charitable fund raising services by means of bicycle rides and entertainment events		

U.S. Registration No.	3798045	Application Date	02/05/2008
Registration Date	06/08/2010	Foreign Priority Date	NONE
Word Mark	TREK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 2000/04/28 First Use In Commerce: 2000/04/28 Exercise equipment, namely, stationary trainers for use with bicycles

U.S. Registration No.	3900734	Application Date	06/17/2010
Registration Date	01/04/2011	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 2009/08/01 First Use In Commerce: 2009/08/01 Electric Bikes		

U.S. Registration No.	3900782	Application Date	07/15/2010
Registration Date	01/04/2011	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2007/10/11 First Use In Commerce: 2007/10/11 Conducting workshops and seminars in properly fitting bicycles for individual bicyclists; Instruction in the field of properly fitting bicycles for individual bicyclists

U.S. Registration No.	3979036	Application Date	02/17/2010
Registration Date	06/14/2011	Foreign Priority Date	NONE

Word Mark	TREK
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Design Mark	
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Description of Mark	The mark consists of a stylized shield design, on which appears 4 vertical curved lines. The word "TREK" appears on the top border of the shield design.
Goods/Services	Class 025. First use: First Use: 2010/08/31 First Use In Commerce: 2010/08/31 Cycling apparel, namely, jerseys and shorts, hats, tshirts

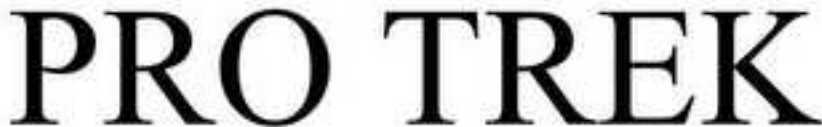
U.S. Registration No.	4021852	Application Date	11/10/2010
Registration Date	09/06/2011	Foreign Priority Date	NONE


Word Mark	TREK BICYCLES OF TUCSON
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Design Mark	
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Description of Mark	The mark consists of standard letters with the word "Trek" on top of the words "Bicycles of Tucson".
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Goods/Services	Class 035. First use: First Use: 2007/06/04 First Use In Commerce: 2007/06/04 Retail stores featuring bicycles
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U.S. Registration No.	4077999	Application Date	11/18/2010
Registration Date	12/27/2011	Foreign Priority Date	NONE
Word Mark	PRO TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2011/05/01 First Use In Commerce: 2011/05/01 electronic wrist watches		

U.S. Registration No.	4372869	Application Date	07/15/2010
Registration Date	07/23/2013	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Health club services, namely, providing instruction and equipment in the field of physical exercise; Providing assistance, personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living; Training services in the field of physical exercise		


U.S. Registration No.	4599850	Application Date	07/10/2013
Registration Date	09/09/2014	Foreign Priority Date	NONE
Word Mark	TREK		

Design Mark	<h1>Trek</h1>
Description of Mark	NONE
Goods/Services	Class 012. First use: First Use: 1995/08/01 First Use In Commerce: 1995/08/01 Trailers for bicycles


U.S. Registration No.	4608677	Application Date	12/10/2013
Registration Date	09/23/2014	Foreign Priority Date	NONE
Word Mark	TREK CARE		
Design Mark	<h1>Trek Care</h1>		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2013/08/01 First Use In Commerce: 2013/08/01 Administration of a customer loyalty program which provides discounts on replacement bicycle and electric bicycle partsnot covered by warranty Class 036. First use: First Use: 2013/08/01 First Use In Commerce: 2013/08/01 Warranty claims administration services, namely, processing warranty claims forbicycle and electric bicycle parts		

U.S. Registration No.	4647933	Application Date	11/13/2013
Registration Date	12/02/2014	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark	<h1>Trek</h1>		
Description of	NONE		

Mark	
Goods/Services	<p>Class 035. First use: First Use: 1995/12/15 First Use In Commerce: 1995/12/15 Provision of professional cycling services, namely, providing support services during cycling events in the nature of team marketing, rider marketing; arranging and conducting incentive reward programs to promote the sale of bicycles, cycling accessories, and cycling services; promotional sponsorship of individuals in sports and/or a sports team; organizing, arranging and conducting individual and team bicycle racing events for promotional purposes; information relating to all the aforementioned services provided on-line from a computer database or via a helpline or the internet</p> <p>Class 041. First use: First Use: 1995/12/15 First Use In Commerce: 1995/12/15 Organization of cycling events; organizing, arranging, and conducting individual and team bicycle racing events; information relating to all the aforementioned services provided on-line from a computer database or via a helpline or the internet</p>

U.S. Application No.	86674667	Application Date	06/25/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 038. First use: First Use: 0 First Use In Commerce: 0 Streaming of audio material on the internet; streaming of video material on the internet; electronic delivery of images and photos via a global computer network</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 Entertainment services, namely, providing a website featuring multimedia material in the nature of video recordings, video stream recordings and podcasts in the field of cycling; providing news and information in the nature of statistics and trivia in the field of cycling</p>		

U.S. Application No.	86743992	Application Date	09/01/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TREK		

Design Mark	
Description of Mark	The mark consists of the word "TREK" instylized font.
Goods/Services	Class 012. First use: First Use: 2009/00/00 First Use In Commerce: 2009/00/00 bicycles and bicycle frames

Attachments	75933601#TMSN.png(bytes) 78171262#TMSN.png(bytes) 76599435#TMSN.png(bytes) 78447581#TMSN.png(bytes) 77221529#TMSN.png(bytes) 77433264#TMSN.png(bytes) 77536257#TMSN.png(bytes) 77388493#TMSN.png(bytes) 77476296#TMSN.png(bytes) 77797825#TMSN.png(bytes) 77388536#TMSN.png(bytes) 85065052#TMSN.png(bytes) 85085570#TMSN.png(bytes) 77937970#TMSN.png(bytes) 85173419#TMSN.png(bytes) 85179666#TMSN.png(bytes) 85085438#TMSN.png(bytes) 86006347#TMSN.png(bytes) 86139775#TMSN.png(bytes) 86117686#TMSN.png(bytes) 86674667#TMSN.png(bytes) 86743992#TMSN.png(bytes) 02.11.16 TREKNOLOGY 24525.pdf(463295 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Lisa A. Harkins/
Name	Lisa A. Harkins
Date	02/11/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of U.S. Application Serial No. 86/740,842
For: TREKNOLOGY
Filed: August 28, 2015
Date of Publication: January 19, 2016

TREK BICYCLE CORPORATION

Opposer,

v.

KATSUHIKO NIITSUMA

Applicant.

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Opposition No. _____

NOTICE OF OPPOSITION

Opposer, Trek Bicycle Corporation ("Opposer"), a Wisconsin corporation with its principal place of business at 801 West Madison Street, Waterloo, Wisconsin 53594, believes it will be damaged by registration of the mark TREKNOLOGY, Serial No. 86/740,842, and hereby opposes the same, in accordance with Section 13 of The Trademark (Lanham) Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, Trek alleges as follows:

1. Upon information and belief, Katsuhiko Niitsuma ("Applicant") is a Japanese individual with his principal place of business at 3-8-8 Ikebukuro, Toshima-ku, Tokyo 171-0014, Japan.

2. As evidenced by the publication of Serial No. 86/740,842 in the Official Gazette of January 19, 2016, Applicant seeks to register TREKNOLOGY (the "Opposed Mark") in connection with:

"Handbag frames; purse frames; industrial packaging containers of leather; clothing for domestic pets; bags and the like, namely, handbags, sport bags, carry-all bags; pouches and the like, namely, pouches for packaging of leather, Drawstring pouches, Japanese utility pouches (shingen-bukuro), Leather pouches; Unfitted vanity cases; umbrellas and their parts; walking sticks; canes; metal parts of canes and walking-sticks; handles for canes and walking-sticks; saddlery; Unworked or semi-worked leather; fur sold in bulk" in Class 18 and

"Non-Japanese style outerclothing, namely, jackets, pants, shirts, skirts; coats; sweaters; shirts; nightwear; underwear; swimwear; swimming caps; camisoles; tee-shirts; Japanese traditional clothing, namely, Japanese sleeping robes (nemaki), bustle holder bands for obi, Kimonos; sleep masks; aprons; collar protectors; socks and stockings; puttees and gaiters; fur stoles; shawls; scarves; Japanese style socks (tabi); Japanese style socks covers (tabi covers); gloves and mittens; neckties; neckerchieves; bandanas; thermal underwear; mufflers; ear muffs; nightcaps; headwear; garters; sock suspenders; suspenders; waistbands; belts for clothing; footwear not for sports; clothes for sports, namely, tights, tank tops, shorts, uniforms; special footwear for sports" in Class 25.

3. Upon information and belief, Applicant filed Serial No. 86/740,842 on August 28, 2015 based on an intent to use the mark in commerce in connection with the claimed goods.

4. Since at least 39 years prior to the filing date for Serial No. 86/740,842, Opposer adopted and has continuously used the trade name "TREK" in connection with its business activities.

5. Opposer has invested substantial amounts of time, effort and money in protecting and policing its TREK trade name in the United States and throughout the world. As such, Opposer has extensive, non-registered statutory and common law rights in and to its TREK trade name, which Opposer uses in connection with its business activities.

6. Since at least 38 years prior to the filing date for Serial No. 86/740,842, Opposer adopted and has continuously used its TREK trademark in connection with bicycles, bicycle frames, and bicycle parts and accessories.

7. Opposer has expanded its trademark use of TREK and TREK-type marks to cover numerous additional products and services, including but not limited to, bags and clothing.

8. Opposer is the owner of the following U.S. Trademark registrations:

Registration No. 1,168,276 for TREK for "bicycles and bicycle frames";

Registration No. 1,989,281 for TREKKING for "bicycles";

Registration No. 1,994,479 for TREK 100 for "providing ride support vehicles in competitive and recreational events, namely, bicycle tours, bicycle races, and triathlons";

Registration No. 2,060,274 for TREK for "exercise equipment, namely, stationary exercise cycles," "bicycles," "cycling computers," and "head protective helmets for bicycle users," among other things;

Registration No. 2,687,012 for ETREK for "online retail and wholesale store services, featuring a wide range of consumer products, except footwear, all provided via the Internet";

Registration No. 2,742,116 for TREK Stylized for "bicycles and bicycle frames";

Registration No. 2,745,442 for TREK for "bicycling apparel, namely, bicycling jersey; form fitting and reinforced seat elastic shorts; ankle length socks; wind resistant jackets with enhanced visibility fabric, extra sleeve length, high collar and extended length back panel; vests with enhanced visibility fabric, high collar and extended length back panel" and "padded and reinforced fingerless bicycling gloves";

Registration No. 2,876,977 for TREKLITE for "orienteering equipment and clothing for outdoor sporting activities, namely protective outer wear" and "orienteering equipment and clothing for outdoor sporting activities, namely, leggings, pants, gators, shirts, and jackets";

Registration No. 3,031,210 for TREK TRAVEL for "travel arrangement of bicycling tours," "sporting and cultural activities related to bicycling," and "services for providing food and drinks, temporary accommodation, all related to bicycling activities";

Registration No. 3,042,834 for TREK UNIVERSITY for "instruction and training services, in the field of retailing bicycles, bicycle clothing and bicycle accessories; and in the fields of bicycle safety, bicycle recreation, bicycle service and bicycle repair";

Registration No. 3,053,077 for TREK for "backpacks, textile tote bags, messenger bags, rack trunks, saddle bags, bicycle seat packs, and all-purpose sports bags";

Registration No. 3,066,516 for TREKER for "off road all-

terrain utility vehicles";

Registration No. 3,397,739 for TREK BICYCLE STORE for "retail stores featuring bikes";

Registration No. 3,516,346 for TREK for "online retail and wholesale store services featuring a wide range of consumer products except footwear all provided via the Internet";

Registration No. 3,576,106 for TREK STOP for "retail vending services in the field of automated vending machines that dispenses bicycle parts, bicycle accessories, energy bars, beverages and gels";

Registration No. 3,653,169 for TREK 100 for "charitable fund raising services by means of bicycle rides and entertainment events";

Registration No. 3,709,688 for TREK for "powders used in the preparation of sports drinks and energy drinks";

Registration No. 3,789,682 for TREK for "charitable fund raising services by means of bicycle rides and entertainment events";

Registration No. 3,798,045 for TREK for "exercise equipment, namely, stationary trainers for use with bicycles";

Registration No. 3,900,734 for TREK for "electric bikes";

Registration No. 3,900,782 for TREK for "conducting workshops and seminars in properly fitting bicycles for individual bicyclists; Instruction in the field of properly fitting bicycles for individual bicyclists";

Registration No. 3,979,036 for TREK and Design for "cycling apparel, namely jerseys and shorts, hats, t-shirts";

Registration No. 4,021,852 for TREK BICYCLES OF TUCSON for "retail stores featuring bicycle";

Registration No. 4,077,999 for PRO TREK for "electronic wrist watches";

Registration No. 4,372,869 for TREK for "health club services, namely, providing instruction and equipment in the field of physical exercise; Providing assistance, personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living; Training services in the field of physical exercise";

Registration No. 4,599,850 for TREK for "trailers for bicycles";

Registration No. 4,608,677 for TREK CARE for "administration of a customer loyalty program which provides discounts on replacement bicycle and electric bicycle parts not covered by warranty" and "warranty claims administration services, namely, processing warranty claims for bicycle and electric bicycle parts"; and

Registration No. 4,647,933 for TREK for "provision of professional cycling services, namely, providing support services in the nature of team marketing, rider marketing; arranging and conducting incentive reward programs to promote the sale of bicycles, cycling accessories, and cycling services; promotional sponsorship of individuals in sports and/or a sports team; organizing, arranging and conducting individual and team bicycle racing events for promotional purposes; information relating to all the aforementioned services provided on-line from a computer database or via a helpline or the internet" and "organization of cycling events; organizing, arranging, and conducting individual and team bicycle racing events; information relating to all the aforementioned services provided on-line from a computer database or via a helpline or the internet."

These registrations are valid, subsisting, uncanceled and are evidence of Opposer's exclusive right to use TREK and the other identified marks in commerce in connection with the goods and services specified in the registrations.

9. Opposer also owns U.S. Trademark Application Serial No. 86/674,667 for TREK for "streaming of audio material on the internet; streaming of video material on the internet; electronic delivery of images and photos via a global computer network" and "entertainment services, namely, providing a website featuring multimedia material in the nature of video recordings, video stream recordings and podcasts in the field of cycling; providing news and information in the nature of statistics and trivia in the field of cycling" and Application No. 86/743,992 for TREK Stylized for "bicycles and bicycle frames."

10. Since at least as early as the respective dates of first use stated in its applications and registrations, Opposer has used its marks in connection with the sale of goods and services covered by those registrations. Such use has not been abandoned, and the public has come to associate Opposer's goods and services with the TREK trademark and trade name.

11. Prior to the filing date of Serial No. 86/740,842 Opposer's TREK mark had become famous for Opposer's goods and services.

12. Applicant has no license, consent or permission from Opposer to use or register the Opposed Mark.

13. The Opposed Mark so resembles Opposer's TREK mark, trade name and other TREK-formative marks that it is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of The Trademark (Lanham) Act of 1946, 15 U.S.C. § 1052(d); and more particularly, the Opposed Mark and use thereof are likely to cause confusion in, or to cause mistake by, or to deceive the trade and purchasing public into believing that the goods in Serial No. 86/740,842 originate with Opposer or otherwise are authorized, licensed or sponsored by Opposer.

14. On April 18, 2000, the Trademark Trial and Appeal Board issued a decision in favor of Opposer and against a different applicant seeing to register TREKNOLOGY in Class 18. The decision refused registration of the application and found that Opposer's TREK mark is famous. Trek Bicycle Corporation v. Alyx Fier, Trademark Trial and Appeal Board Opposition No. 103,859, a copy of which is attached at Exhibit A.

15. By reason of all the foregoing, Opposer will be damaged by the registration of the Opposed Mark for the goods covered by Serial No. 86/757,613, because registration of the mark would be in violation of Opposer's trademark and trade name rights.

WHEREFORE, Opposer prays that this Notice of 86/740,842 be denied registration. Trek submits herewith its payment of the \$600 filing fee, as required by 37 C.F.R. §2.6(a)(17).

Respectfully submitted,

TREK BICYCLE CORPORATION

A handwritten signature in cursive script, reading "Mary Catherine Merz".

Date: February 11, 2016 By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition was served on Applicant by U.S. Mail this February 11, 2016, addressed to:

Kumiko Ide
Westerman Hattori Daniels & Adrian LLP
1250 Connecticut Avenue NW
Suite 700
Washington, District of Columbia 20036-2657

By:



Lisa A. Harkins

EXHIBIT A

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Cissel
THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB 4/18/00

Opposition No. 103,859

Trek Bicycle Corp.

v.

Alyx Fier

Before Sams, Cissel and Bottorff, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 6, 1996, Alyx Fier, an individual, applied to register the mark "TREKNOLOGY" on the Principal Register for "travel and all purpose athletic bags," in Class 18. Applicant claimed first use of the mark on these products in September of 1991, and first use in interstate commerce in August of 1993.

A timely notice of opposition was filed by opposer on October 29, 1996. As grounds for opposition, opposer asserted ownership of a registration¹ for the mark "TREK" and prior use of it as a trademark for bicycles, bicycle frames and related products since 1976; that in addition to

¹ Reg. No. 1, 168,276, issued on the Principal Register on Sept. 8, 1981. Affidavit under Sections 8 and 15 filed and accepted.

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bicycles, opposer also uses its "TREK" mark on travel bags and all-purpose athletic bags; that such bags have been sold bearing the "TREK" mark since at least as early as 1988; that many of opposer's "TREK" bags are designed for general use and are not limited to use in connection with bicycles; that opposer is recognized as a leader in bicycle technology and innovation; that, as a result of extensive use and promotion, the mark "TREK" has become a famous trademark; that, prior to applicant's use of the mark he seeks to register, opposer had used and promoted "TREKNOLOGY" as a "trade identity designation in its catalogues and sales literature" in connection with opposer's bicycles and related products; that opposer's ownership of registrations for the marks in "TREKKING" and "TREK 100" establish that opposer owns a family of "TREK" marks; and that applicant's mark, as applied to the goods set forth in the application, so resembles opposer's "TREK" mark and opposer's "TREKNOLOGY" designation that confusion is likely.

Applicant's answer essentially denied these allegations.

This case now comes before the Board for consideration of opposer's motion for summary judgment, filed on August 17, 1998, and applicant's cross-motion for summary judgment,

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filed, along with applicant's response to opposer's motion,² on October 7, 1998. Opposer's response to applicant's cross-motion for summary judgment has, of course, also been considered.

In support of its motion for summary judgment, opposer has submitted extensive evidence, namely two volumes of documents, including the depositions of three witnesses and a copy of the unpublished opinion of this Board in Opposition No. 94,948. In that case, we held confusion to be likely between the mark of applicant shown below,

as applied to the same goods specified in the instant application, and opposer's registered "TREK" mark in connection with opposer's bicycle products and travel bags and all-purpose athletic bags.

Opposer's position is that the materials submitted in connection with its motion and applicant's cross-motion establish that there are no genuine issues of material fact

² Notwithstanding previous admonishment by the Board for filing papers late in this proceeding, applicant nonetheless requested the Board to consider its late-filed response and cross-motion. Opposer has objected. In view of the policy of the Board to resolve cases on their merits wherever it is possible and applicant's assertion that the delay was unavoidable, as well as the fact that the impact of the delay was minimal, we have once again exercised our discretion by considering applicant's untimely submission.

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in dispute in the instant case, and that, based on the undisputed facts, opposer is entitled to summary judgment in its favor as a matter of law. Opposer also argues that in view of the Board's decision in the earlier opposition proceeding, the principle of collateral estoppel requires the Board to render judgment in the case at hand in favor of opposer at this juncture, prior to a trial.

In response to opposer's motion for summary judgment, applicant argues that the existence of "numerous" genuine issues of fact makes summary judgment for opposer inappropriate. Applicant does not identify any such issues, however. Instead, in apparent recognition of the fact that there are no disputes with respect to any material facts in this case, applicant contends that based on the undisputed facts, applicant, rather than opposer, is entitled to summary judgment. Accordingly, applicant moves for summary judgment in his favor, and asks the Board to dismiss the opposition. Attached to its cross-motion and opposition to opposer's motion were a number of exhibits, most of which had been submitted in connection with Opposition No. 94,948.

As has often been stated, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the

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initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). The evidence must be viewed in the light most favorable to the nonmovant, and all justifiable inferences are to be drawn in favor of the nonmovant. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA*, supra.

When we apply these principles to the situation in the instant case, we find that we are in agreement with both applicant and opposer that there remain no genuine issues of material fact, and that a trial is therefore unnecessary. Although we do not agree with opposer that opposer is entitled to judgment in this case because our decision in Opposition No. 94,948 has already resolved the issues before us in the instant proceeding, it is clear that based on the undisputed facts established by the materials of record in connection with these cross-motions for summary judgment, opposer has priority and confusion is likely between

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applicant's mark and opposer's previously used and registered mark "TREK."

Just as in the earlier opposition, we find it unnecessary to determine whether opposer's very limited use of the designation "TREKNOLOGY" in connection with its bicycles constitutes sufficient use as a trademark to bar registration of applicant's mark. Opposer's prior use of "TREK" in connection with both bicycles and travel and all-purpose bags establishes the basis for refusing to register applicant's mark under Section 2(d) of the Act.

Contrary to opposer's contentions, our decision is not based on a finding that opposer has established a family of marks which have "TREK" in common with each other. Although the materials of record in connection with opposer's motion show that opposer has adopted and used several marks incorporating this term, we have no evidence that opposer has promoted these marks together, or has referred to them as members of a family of "TREK" marks owned by opposer. Without such a showing, we cannot conclude that opposer is entitled to claim that it has a family of such marks. *Porta-Tool, Inc. v. DND Corp.*, 196 USPQ 643 (TTAB 1977).

As noted above, collateral estoppel is not the basis for our decision either. As even opposer acknowledges (brief, p.4), the first requirement to be met in order for collateral estoppel to apply is that the issue decided in

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the prior action must be identical to the one now under consideration. Plainly, the issue in Opposition No. 94,948 was whether confusion was likely in view of a mark which was different from the one with which we are concerned in the case now before us. The mark in the case at hand is a typed presentation of the term "TREKNOLOGY," whereas the mark in the prior proceeding included a significant design element, which the Board commented had the effect of separating and highlighting the "TREK" portion of that trademark. Because of the difference between that mark and the block letter presentation of the term "TREKNOLOGY" which is now sought to be registered, our decision in the prior case finding confusion to be likely with respect to that mark is not determinative of the outcome in the instant proceeding.

We are not persuaded to the contrary by opposer's argument that whatever similarity is reduced by the unification of "TREK" and "NOLOGY" in the instant case is more than compensated for by the removal of the otherwise distinguishing design element in applicant's previously opposed mark. The simple fact is that distinctions can be readily drawn between each of applicant's two marks, and these distinctions have relevance to the question of why confusion with opposer's mark "TREK" would or would not be likely. Because the issue in this proceeding is not

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identical to the one we decided in the prior case, collateral estoppel does not apply.

Even though our decision in Opposition No. 94,948 is therefore not controlling in this one, opposer has submitted sufficient evidence to establish that there are no genuine issues of fact which would require a trial to resolve. The materials of record, including the testimony Mr. Sullivan, Mr. Norquist, and Mr. Gordon, as well as the exhibits thereto and a host of other documents made of record in connection with the motions, clearly demonstrate that opposer's mark "TREK" is famous for bicycles and accessories, and that opposer has used this mark in connection with goods which are encompassed within the identification-of-goods clause in the opposed application since 1988, which is long before applicant adopted its mark.

The fame of opposer's "TREK" mark carries great weight in our resolution of whether confusion is likely in this case. As our reviewing court has made clear, famous marks are afforded more protection against confusion. *Kenner Parker Toys v. Rose Art*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Particularly in view of the fame of opposer's mark, applicant's mark so resembles opposer's mark that when both marks are used on the same kinds of products, confusion is likely.

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Applicant's "TREKNOLOGY" mark embodies opposer's famous "TREK" mark in its entirety, and adds to it the clear reference to technology. Just as in the earlier proceeding between these parties, the materials of record in connection with the motions establish that opposer's advertising and promotion seek to emphasize that "TREK" bicycles embody the highest technology available in this field. Opposer's very limited use of the term "TREKNOLOGY" in connection with its top-of-the-line bicycles exemplifies this, and the record is replete with other examples of opposer touting its technological orientation. This fact and the obvious play on words created by combining "TREK" and "NOLOGY" facilitates the association between "TREKNOLOGY" and "TREK" in the minds of consumers.

People who are familiar with opposer's famous "TREK" bicycles and who are aware that "TREK" travel and all-purpose bags are also sold under this famous trademark are likely to assume, when essentially identical bags are sold under the mark "TREKNOLOGY," that they emanate from the same source which is responsible for products sold under the famous "TREK" mark. It is well settled that when marks are used on virtually identical goods, the degree of similarity necessary to support a conclusion that confusion is likely declines. *Century 21 Real Estate v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

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Applicant's arguments and the documents attached to applicant's brief in opposition to opposer's motion for summary judgment and in support of applicant's cross-motion for summary judgment do not reveal the existence of any genuine issues of material fact, nor do they dictate judgment for applicant as a matter of law. Applicant's main point appears to be that because he is aware of no incidents of actual confusion, the issue of whether confusion is likely should be resolved in the negative. As this Board has frequently stated, however, the issue is not whether confusion has actually occurred, and evidence of actual confusion is notoriously hard to obtain. *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Rather, the issue is whether confusion is likely, and in situations like the one before us, where we have no evidence which would lead us to conclude that the opportunity for confusion has existed to any significant extent, the assertion by one party that it is not aware of any incidents of actual confusion carries little weight.

Applicant's other arguments are equally unpersuasive. For example, applicant contends that the fact that the word "trek" has a dictionary definition and is linked with travel to the Himalayas somehow makes opposer's famous trademark a generic term in connection with bicycles and packs. Applicant also argues that third-party trademark

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registrations for marks which include the word "trek" establish that opposer's famous trademark has become diluted. We have no evidence that any of the referenced marks are in use, however, so we have no basis upon which to adopt the position asserted by applicant. To the contrary, in light of the substantial evidence submitted by opposer, as noted above, opposer has established that its mark is a famous, strong mark in its field.

In summary, the Board agrees with both applicant and opposer that no genuine issues of material fact are in dispute, and that judgment can be rendered at this juncture without the necessity of a trial. The materials of record establish opposer's priority and that confusion is likely. Accordingly, summary judgment in favor of opposer is granted. The opposition is sustained and registration to applicant is refused.

J. D. Sams

R. F. Cissel

C. M. Bottorff
Administrative Trademark Judges,
Trademark Trial & Appeal Board

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